

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Of: Jeffrey Alger et al.
U.S. Pat. App. No.: 09/859,565
Filed: May 16, 2001
For: Merchant Branded Software

Examiner: Naresh Vig
Group Art Unit: 3629

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450,
Alexandria, Virginia 22313-1450

Sir:

Applicant respectfully asks for reconsideration of both this application and the final Office Action dated May 6, 2005, prior to the submission of an Appeal Brief. This Request is being filed concurrently with a Notice of Appeal.

In the final Office Action, the Examiner rejected claims 1, 2, 5-12, 14-17, 19-22, 26, 30, 31, 33, 34, 36, 37, and 39 35 U.S.C. §112, second paragraph. The Examiner did not actually state a grounds of rejection, however. Instead, the Examiner noted only that some claims recite the term "browser application." Because the Examiner has not stated any actual grounds of rejection to support this rejection, the issuance of this rejection was clear error.

The Examiner also rejected claims 1, 2, 5-12, 14-17, 19-22, 26, 30, 31, 33, 34, 36, 37, and 39 under 35 U.S.C. §102(b) over Web pages ostensibly made available on the Internet by 1stUp.com over dates between November 2, 1999, and February 13, 2001, hereafter referred to as the "1stUp.com pages." It is well established that, to support a rejection under 35 U.S.C.

§102(b), the cited reference must disclose every feature of the invention. The 1stUp.com pages plainly omit at least one feature of the invention recited in the rejected claims. Accordingly, Applicants respectfully submit that the issuance of this rejection was clear error.

Claims 1, 2, 5-12, 14-17, and 19-22 recite that the core portion of the electronic data includes a browser that retrieves and renders content. Similarly, claims 30, 31, 33, 34, 36, 37, recite receiving a software application including a browser for retrieving and rendering content. These recited features of the invention is not taught or suggested in any way by the 1stUp.com pages. Instead, the 1stUp.com pages appear to disclose a small application that is downloaded and used in conjunction with a conventional browser (i.e., a browser that does not evoke an association with a merchant). More particularly, the 1stUp.com pages generally disclose a business method whereby a sponsor provides free Internet access to a customer, in return for the customer continuously maintaining an “always-on” navigation bar with links to the sponsor’s Web sites. (See, e.g., pages 6 and 9 of the 1stUp.com pages.) Applicants respectfully point out that the 1stUp.com pages further disclose that the navigation bar is obtained by “the easy download of a small, 700k application.” (*Id.*, page 11.) Thus, the 1stUp.com pages teach providing the navigation bar to the user separately from the browser software. Moreover, because the 1stUp.com pages teach an application specifically designed to be used with a conventional browser, Applicants submit that the 1stUp.com pages would actually teach away from the invention as recited in claims 1-3, 5-12, 14-17, 19-22, 24 and 25.

With regard to claim 26, this claim recites that the second data field contains functionality branding that provides the core data with at least one function that evokes an

association with a merchant. This feature is not taught or suggested by the 1stUp.com pages. Instead, these pages disclose only a conventional function of having the associated browser access a Web site specified by a sponsor or partner. Applicants therefore submit that the issuance of this rejection was clear error.

Lastly, claims 3, 24, 25, 28, 29, 32, 35, 38, 40-42 and 44-46 were rejected under 35 U.S.C. §102(b) over the 1stUp.com pages. No other references were cited in support for this rejection. As previously noted, these claims recite features that are not taught or suggested in any way by the 1stUp.com pages. In making this rejection, however, the Examiner did not address this deficiency in the single cited reference. Accordingly, Applicants submit that the issuance of this rejection also was clear error.

For at least the reasons stated above, Applicants respectfully submit that the final Office Action issued on March 24, 2006, was clearly erroneous. Applicants therefore courteously urge that this final Office Action, together with the rejections under 35 U.S.C. §112, §102(b), and §103 be reversed.

It is believed that no additional fees are required for the consideration and entry of this Request. If, however, the Commissioner believes fees are required, he is authorized to charge such fees to Deposit Account No. 19-0733.

Favorable action in this regard is courteously requested at the Office's earliest

convenience.

Respectfully submitted,

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